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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,883	03/13/2001	Junichi Umehara	9366/8001	1834
757	7590	12/01/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			GARG, YOGESH C	
			ART UNIT	PAPER NUMBER
			3625	
DATE MAILED: 12/01/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,883

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C. Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 35 and 42 is/are pending in the application.
- 4a) Of the above claim(s) 11-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 35 and 42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/19/2005 has been entered.

Response to Amendment

2. Applicant's amendment received on 9/19/2005 is acknowledged and entered. Claims 11-34 stand withdrawn. Claims 36-41 are canceled. Claims 1 and 8 are amended and claim 42 has been added. Currently claims 1-10, 35 and 42 are pending for examination.

Response to Arguments

3. Applicant's arguments filed on 9/19/2005 have been fully considered but are moot in view of new grounds of rejection necessitated due to amendments to claims 1, 8 and addition of claim 42.

4. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific

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limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Peterson (US Patent 5,740,134).

Regarding claims 1-3 and 42, Peterson teaches a method for online purchasing of electronic information (see at least abstract and Fig.1 which discloses a new Musical CD creation system 10 in which a computerized selection means “30” is in communication via cable “38” with a production unit “40”, that is the stand alone printer means) comprising the steps of:

a) selecting said electronic information, b) paying for said electronic information, c) directly receiving said electronic information by a user printing device and d) printing said electronic information on a medium using the user printing device, sampling said electronic information and e) selectively mixing and ordering a plurality of selected electronic information (see at least col.3, line 50-col.4, line 32, “..... it will be noted that

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the Musical CD Creation Unit 10 comprises a storage means 20, a selection means 30, and a production means 40. The storage means 20 further comprises a CD jukebox 22 of the kind commonly available and used in commercial markets. As best illustrated in FIG. 1, the selection means 30 further comprises a computer terminal 32 having a display monitor 33 and input means, such as a computer keyboard 34 or a touch screen. The selection means 30 is connected to the storage means 20 and the production means 40 by a unit interface cable 38. As best illustrated in FIG. 2, the selection means 30 further comprises a predetermined entry means 39 for allowing a customer to review and record predetermined musical selections by type, such as jazz, pop, rock, country, soul, gospel, or blues, by popularity, such as "Top 20 Hits," by artist, or by other predetermined musical selections. The production means 40 further comprises a CD recorder 42 for recording on a recordable CD 2. After the desired selections are recorded on the recordable CD 2, the recordable CD 2 is dispensed from the production means 40 by a CD dispenser 44, as best illustrated in FIG. 4. To provide fully automated merchandising capabilities, the Musical CD Creation Unit 10 has "vending" features. As best illustrated in FIG. 3, the Musical CD Creation Unit 10 further comprises a payment means 50 having a purchase amount display 56, a magnetic card reader 52 for credit cards, and a currency changer 54 for cash such that a customer can purchase the recordable CD 2 without assistance from store personnel.....". Note: As stated above, the production means "40" directly receives the selected songs information in electronic form for recording/printing it on a medium, such as CD.).

Claim Rejections - 35 USC § 103

6 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-10 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson and further in view of Salisbury et al. (US Patent 6,041,703); hereinafter, referred to as Salisbury.

Regarding claims 4-10, Peterson teaches a method for online purchasing of electronic information by selectively mixing and ordering a plurality of selected electronic information in the form of songs as analyzed for claims 1-3 above. Peterson does not disclose the limitations of claims 4-10. However, in the same filed of printing/recording data on CDs and labeling them, Salisbury suggests all the limitations of claims 3-10, that is : selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information (see at least col.1, lines 31-35, "*The present invention speeds up and improves the steps involved in the manufacturing process for recording and preparing a CD by significantly reducing the number of manual handling steps required to record, verify and print label information on a CD. ... Commercially available compact discs can include some generic pre-printed information on a top surface of the disc. For example, a manufacture of the disc may include an identification mark, logo, or trademark..* ", col.6, lines 1-15, " Referring to FIG. 4, a top surface of a compact disc 90 is illustrated..... As indicated above, preprinted generic information may be located on commercially available compact discs. *This information may be in the form of an image comprising graphics, text, manufacturers identification, logo, trademark, background field, or other types of indicia such as a bar code. For purposes of conciseness, the term "image" is used herein to describe any material provided or printed on a surface of a compact disc and is not limited to textual information, identification, or identifying marks.* ".).

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In view of Salisbury, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Peterson to incorporate the features of selectively labeling said electronic information, printing a user-selected label on said medium, wherein said label includes a photo/title/video scene/concert information. Doing so enables the users to include additional individualized information on the top surface of the compact disc to identify the data recorded/printed on the CD and/or identify the user who prepared that CD or the user who is going to use it himself, as explicitly suggested in Salisbury (see at least col.1, lines 36-52).

Regarding claim 35, all the limitations are already covered in claims 1-10 and therefore it is analyzed and rejected as being unpatentable over Peterson and further in view of Salisbury on the same basis.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


(i) US Patent 6,496,744 to Cook discloses a method and a system for custom purchasing a music CD online wherein a mixed selection of sound tracks, that is electronic information is reviewed and selected and then printed on a medium, such as CD (see at least col.4, line 10-col.11, line 19). The teachings and disclosure of this patent anticipates claims 1-4 and when combined with the prior art of Salisbury renders obvious the claims 4-10 and 35.

(ii) US Patent 6,952,685 to Hunter et al. discloses a method and a system for custom purchasing a music CD online wherein a mixed selection of sound tracks, that is electronic information is reviewed and selected and then printed on a medium, such as CD (see at least col.5, line 13-col.10, line 65). The teachings and disclosure of this patent anticipates claims 1-4 and when combined with the prior art of Salisbury renders obvious the claims 4-10 and 35.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg
Primary Examiner
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YCG

November 22, 2005